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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 25

Application Number: 09/457,669
Filing Date: December 09, 1999
Appellant(s): MOTOYAMA, TETSURO

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For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 02/17/04.

(1) *Real Party in Interest*

A statement identifying the real party of interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments*

The appellant's statement of the status of amendments contained in the brief is correct.

(5) *Summary of the Invention*

The summary of the invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims of the following groups of claims stand or fall together and proved reasons as set forth in 37 CFR 1.192 (c) (7) and (c) (8).

Group I: Claims 52-76.

Group II: Claims 77-10.

Group III: Claims 101-124

(8) ***Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) ***Prior art of record***

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

Beilinski et. al.	U.S. Patent No. 5,123,089	06-1992
Tarr et. al.	U.S. Patent No. 5,184,179	02-1993
Hirtle	U.S. Patent No. 4,750,114	06-1988
Naugle	U.S. Patent No. 5,715,393	02-1998

(10) ***Grounds of Rejection***

1.   Admittance of prior art: Applicant has admitted on the record that the subject matter regarding amended limitation, specifically: electronic mail is transmitted using a protocol layer, which is at the application layer. Therefore, implementation and/or enablement techniques are readily recognized by one ordinary skill in the art. This is taken as being available as prior art against the claims (see MPEP 2129 and 1.131). Hence, the limitation's elements will be construed as encompassing any and every art-recognized hardware or combination of hardware and software technique for implementing the defined requisite functionalities.

2.   The following ground(s) of rejection are applicable to the appealed claims: Claims 52-124 are presented for examination.

3.   The following is quotation of 35 U.SC.§103(a), which forms the basis for all obviousness rejection, set forth in this Office action:

> (a) A patent may be not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art of record are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claim 52 is rejected under 35 U.S.C. §103(a) as being unpatentable over Beilinski et. al. U.S. Patent No. 5,123,089 (Beilinski hereafter)

Regarding claim 52, Beilinski teaches a business office device (24, 26 and 28), which is connected to a monitoring device (12) that monitors the business office device response, the business office device comprising;

at least one memory for storing information to be communicated to the monitoring device communicated information (col 12/lines 51-62 and col 2/lines 47-59), communicated information including sending an electronic mail message to the monitoring device, monitoring the business office device response (col 4/lines 12-47),

an network controller (interface) for bi-directionally communicating information (i.e. transmitting) and electronic mail (e-mail) message (col 6/lines 17-19) containing status information of the business office device to the monitoring device (col 4/lines 12-47, col 12/lines 42-50);

however the reference explicitly teach the e-mail interface is transmitted at the application layer;

It would have been obvious to one ordinary skilled in the art at the time the invention was made that to utilize Beilinski's teachings to execute claimed invention performing the same functions as claimed, and to further enable reference's e-mail interface for transmitting at the application layer an email message, as well known in the art, and for transmitting an e-mail message containing status information to the monitoring device, motivation would be to enable detect the status condition of a business office device such as a printer or modem, improve existing prior art by enabling a peripheral device to send information back to another business office device such as a computer, sending mail messages that indicate the status of the receiving office device or sending an error message, as taught by Beilinski.

6.   Claims 53-124 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beilinski et. al. (Beilinski) U.S. Patent No. 5,123,089 in view of Tarr et. al. (Tarr) U.S. Patent No. 5,184,179.

Regarding claim 53, however the above-mentioned prior art does not explicitly teach communicating with the monitoring device via a telephone system and a modem;

Tarr teaches a business office device (52) transmit status information to the monitoring device (54) (col 3/lines 33-40, col 5/lines 2-30) via telephone system and modem (14), a memory (504, 506) for storing status information (Fig. 6, step 316) (col 3/lines 61-col 4/line 3, col 4/lines 60-67) status information including a multiple portions (col 3/lines 40-49).

It would have been obvious to one ordinary skilled in the art at the time the invention was made to include means for the business office device transmits the status information to the monitoring device at a predetermined interval as taught by Tarr, into Beilinski system enabling the transmission of a first portion of status information, motivation would be improve existing monitoring system by implementing means for automatically notifying off-site parties at appropriate times of status of monitoring devices, as taught by Tarr.

Regarding claim 54, the email interface each can transmit one of the status information portions (Beilinski: col 6/lines 17-19 status information col 4/lines 12-47, col 12/lines 42-50) and direct connection-mode interface can transmit one of the status information portions (Tar: col 3/lines 40-49).

Regarding claim 55, wherein the business office device transmits the first portion of the status information to the monitoring device at a predetermined interval (Tarr: col 3/lines 33-40, col 5/lines 2-30).

Regarding claim 56, event-driven transmission (in response to the receipt of a status message containing an error message (Tarr: col 6/lines 55-col 7/lines 3).

Regarding claims 57-58, persistent memory for storing an assigned identification number (name) of the business office device (Tarr: col 5/lines 37-49, col 10/lines 61-67) and

communication to monitoring device from the business office device enable monitoring device to identify transmitting business office device (Tarr: col 5/lines 37-40).

Regarding claim 59-60, persistent memory storing the telephone number (address) of the business office device and communicating said address to the monitoring device (Tarr: col 5/lines 30-40).

Regarding claims 61-62, status information is transmitted by the email interface (Beilinski: col 6/lines 17-19, col 4/lines 12-47, col 12/lines 42-50), transmitting status information as an email message, monitoring device polls business office device for status information (Tarr: col 6/lines 27-38).

Regarding claims 63-64, business office device is a printer (Tarr; col 2/lines 17-18), persistent memory storing option configuration (Tarr: col 9/lines 6-22).

Regarding claims 65-66, persistent memory stores a model and serial number (Tarr: col 5/lines 30-47).

Regarding claim 67, persistent memory stores characteristics of said business office device, which do not change over a life of said business office device (e.g. serial number discussed above).

Regarding claim 68, dynamic memory stores dynamic data (Tarr: col 3/lines 61-col 4/line 3).

Regarding claims 69, 71, 72, 73 and 75, dynamic memory stores an indication of a paper tray present in the business office device and indication of a status of paper in a paper tray present in the business office device (Tarr: col 3/lines 16-31, col 5/lines 60-col 6/line 2), an indication of consumable goods (e.g. oil), amount of toner, number of prints in the business office device (Tarr: col 5/lines 60-col 6/line 2).

Regarding claims 70 and 74, storing in a dynamic memory an indication of a voltage used (Tarr: col 8/lines 56-67) and an indication of a sensitivity of photoreceptor in the business office device (Tarr: col 5/lines 60-col 3/line 2).

Regarding claim 76, substantially the same as claim 52 and further the business office device and monitoring device discussed above are comprised in a business system (Tarr: col 10/lines 5-18) and said monitoring device is monitoring from a remote location (Tarr: col 3/lines 10-40).

Regarding claim 77, as discussed on claims 52 and 76, the monitoring device monitors the business office device from a remote location (Tarr: col 3/line 16-40), storing within the system, status information of the business office device (Tarr: col 4/lines 60-col 5/line 8, diagnostic status data stored in RAM 28, col 7/lines 66-col 8/line 6, storing status information col 10/lines 53-66).

Regarding claim 78, establish a direct connection mode via terminal-based interface (i.e. interface linked to a telephone system from the monitored business office device to the monitoring device through a modem, Tarr: col 3/lines 33-40, col 5/lines 2-30 via telephone system and modem for transmitting status information portion across said link (Tarr: col 11/lines 17-26, maintenance status information, col 5/lines 3-13, col 14/line 63-col 15/line 2).

Regarding claim 79, first and second portion of status information are stored in the same (one) memory (Tarr: col 4/lines 60-col 5/line 8, diagnostic status data stored in RAM 28, col 7/lines 66-col 8/line 6, storing status information col 10/lines 53-66).

Regarding claims 80-100 are the monitoring method associated with the business office device discussed on claim, and substantially, same rationale is applicable.

Regarding claims 101-124, this claim is the computer program product, comprising: a computer storage medium and a computer program code mechanism embedded in the computer storage medium for

monitoring a business office device, the computer program code mechanism comprising the computer code configured to perform the method discussed on claims 77-100, same rationale is applicable.

7.   Claims 52, 76, 77 and 101 may also be rejected under 35 U.S.C. 103(a) as being unpatentable over Beilinski et. al. (Beilinski) U.S. Patent No. 5,123,089 in Hirtle U.S. Patent No. 4,4750,114.

Regarding claim 52, Beilinski teaches a business office device (24, 26 and 28), which is connected to a monitoring device (12) that monitors the business office device response, the business office device comprising;

at least one memory (col 17/lines 41-47, storing sending/receiving information, col 3/lines 61-66, col 3/lines 7-12) for storing information to be communicated to the monitoring device communicated information, communicated information including sending an electronic mail message to the monitoring device, monitoring the business office device response (col 4/lines 12-47),

an network controller (interface) for bi-directionally communicating information (i.e. transmitting) and electronic mail (e-mail) message (col 6/lines 17-19) containing status information of the business office device to the monitoring device (col 4/lines 12-47, col 12/lines 42-50); however the reference explicitly teach the electronic e-mail is transmitted using a protocol which is at the application layer.

Hirtle teaches a system/method related to the transmission of data, including where the electronic e-mail is transmitted using a protocol, which is at the application layer, (col 4/lines 8-18).

It would have been obvious to one ordinary skilled in the art at the time the invention was made to include means for transmitting an e-mail message as taught by Hirtle, motivation would be utilize standard enabled widely used technology, such as Internet technology based on the OSI model in which group of protocols, or rules for communicating are arranged in layer, each performing a specific data communication function, as well known in the art.

Regarding claim 76, substantially the same as claim 52 and further the business office device and monitoring device discussed above are comprised in a business system (Beilinski: col

6/lines 31-48) and said monitoring device is monitoring from a remote location (Beilinski: col 6/lines 31-48).

Regarding claim 77, as discussed on claims 52 and 76, the monitoring device monitors the business office device from a remote location (Beilinski: col 6/lines 31-48), storing within the system, status information of the business office device (Beilinski: col 17/lines 41-47, col 3/lines 61-66, col 3/lines 7-12, col 4/lines 12-47).

Regarding claims 101-124, this claim is the computer program product, comprising: a computer storage medium and a computer program code mechanism embedded in the computer storage medium for monitoring a business office device, the computer program code mechanism comprising the computer code configured to perform the method discussed on claims 77-100, same rationale is applicable.

8.   Claims 52, 76, 77 and 101 may also be rejected under 35 U.S.C. 103(a) as being unpatentable over Naugle U.S. Patent No. 5,715,393.

As exemplary in regards to claim 52, Naugle teaches substantial features of the invention as claimed, teaching a business office device (12) connected to a monitoring device (11) that monitors the business office device (col 2/lines 41-47);

transmitting at an application layer (col 3/lines 23-25, 30-31), an email containing (first portion) status information to the monitoring device (11) (col 4/lines 4-9, col 5/lines 23-24, col 6/lines 34-36, 46-52);

a memory for storing status information of the business office device (12) (col 4/lines 29-36, col 6/lines 50-59), although the all claimed functionalities are met by the prior art, prior art does not call the target computer (12) a "business office device" nor the monitoring computer (11) a "monitoring device".

The differences of a nomenclature nature between the subject matter sought to be patented and the prior art, although not identically disclosed as set forth in section 102, are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art in view of the teachings of the prior art of record.

(11)   Response to Arguments

1.   Regarding claims 52-76 (Group I), it is argued (pages 4-5) that the prior art Beilinski does not teach claim limitation as recited, specifically an business office device comprising: the memory and email interface features as recited in the claims, because the elements (network node controller 18-22 of Fig. 1) of the Beilinski reference *are not found within* the input/output devices (24-28) ("business office devices").

In response to the above-mentioned argument, the memory and the email interface limitation features of claims (e.g. 52) are not required to be "**within**" the business office device. (1) Beilinski teaches that the "network controller can be configured either as a serial or parallel device to its corresponding input device or computer and independently configured as a serial or parallel input device to its output device or printer..." (see col 19/lines 16-23). Thereby, the input/output device comprises a network controller. (2) The transitional term "comprising", which is synonymous with "including", "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., Genentech, Inc. v. Chiron Corp., 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.); Moleculon Research Corp. v. CBS, Inc., 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); In re Baxter, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); Ex parte Davis, 80 USPQ 448, 450 (Bd. App. 1948) ("comprising" leaves "the claim open for the inclusion of unspecified ingredients even in major amounts"). Thereby, the transitional term comprising is **not** construed as meaning "including within", "containing within" or enclosed within the business office device, as argued.

2.   Regarding claims 52-76 (Group I), it is argued (on page 5) that the prior art Beilinski does not teach claim limitation as recited, specifically an business office device comprising: the memory and email interface features as recited in the claims, because the elements of network node controller 18-22 in the Beilinski reference memory element *is not actually part of* the business office device (i.e. input/output devices 24-28) and *email does not originate in* any of the input/output devices (24-28).

In response to the above-mentioned argument, Beilinski teaches that each receiving network controller must maintain a small buffer to receive data frames to send the data to its corresponding object

device (see col 12/lines 51-62), the sending network controller send data from it memory within the sending network controller (col 2/lines 47- 59), and wherein the "network controller can be configured as a serial device to its corresponding input device and independently configured as an input device to its output device or printer" (see col 19/lines 16-23). Regarding where email are originate, it is noted that the claim does not require an email originating in any device, claims are silent as to where email messages are originated.

3.   Regarding claims 52-76 (Group I), it is further argued (on page 6), there is not motivation to modify the Beilinski patent to incorporate the network controller into the devices, because this would *alter the principle of operation of the network controller.* According to applicant's interpretation of the reference, the network controller is designed with keypads thereon for selecting which printer to be used. Thereby, if the network controller would be integrated in to the input/output devices (business office devices), this would require the devices to be located closer to the user, would increase cost and the network controller's collision detection functions would raise operational questions as to how it operates.

In response to the above-mentioned argument, applicant's interpretation of the Beilinski reference is noted. However, Beilinski's teachings invention is direct to the improvement of an existing commercially available device. Beilinski's invention employs a device in which the invention is incorporated. "The network node controller 18-22 is capable of being intelligently controlled, either by the user through a series of push button control which comprise the keyboard of each controller, or through embedded commands included within the data transmitted from the computer 12-16 to network controllers 18-22, respectively (col 6/lines 31-48). The user prepares to print from his application or program, he selects by using the keyboard or including the appropriate software command within his data (user send a print job commands via software commands see col 7/lines 39-54 and user sends commands to the printer through his computer see col 9/lines 23-28). Thereby, the keyboard is an *alternative* form of input, the network controller is operable and configured to operate without a keyboard, because it is explicitly disclosed in the reference. Arguments that the principal of operation of the network controller is altered if the controller would be incorporated in the input/output devices is not persuasive.

4.   Regarding claim 52-76, rejected under 103(a) as being unpatentable over Beilinski in view of Tarr, applicant argues, prior art does not teach claim limitation as recited, specifically the memory and email interface limitations/features, because neither the memory nor the email interface *are elements of* the business office device and email communication *is not from business office device.*

In response to the above-mentioned argument that the reference fails to show certain features of applicant's claimed invention, it is noted that the features upon which applicant relies on (i.e. "at least one memory within the business office device", "an email interface within the business office device" nor "an email interface for transmitting email from the business office device") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns,* 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

5.   Regarding claims 52-76 (Group I), specifically (on page 7), with respect to the secondary references Tarr (US 5,184,179), Hirtle (US 4,750,114) and Naugle (US 5,715,393), it is argued that the office action as not asserted that where these references teach "an email containing a first portion of the status information to the monitoring device". Broadly speaking (see MPEP §2111) claim recites, sending an email containing information (called "status information") to another device.

In response to the above-mentioned argument, claim (52) limitation reads, an email interface for transmitting to the monitoring device an email containing status information. Regarding rejection of claim 52 over Naugle (US 5,715,93). Naugle teaches generating a status report, which is returned to the monitoring computer by means of an electronic mail message (see abstract), target computer (business office device) generates a status report, which is returned to the monitoring computer by means of an email message (see col 4/lines 10-20). Thereby, Naugle teaches sending an email containing information to another device. Regarding rejection of claim 52 over Beilinski in view of Hirtle, and Beilinski alone.

The Beilinski reference teaches transmitting to a device an email containing information. Specifically, the reference teaches the operation of a network electronic mail session, where network mail sessions refer and includes the transmission of an mail message (or "email message

frames") send from a sending network controller to a receiving network controller (col 12/lines 3-9, 14-16, sent email contains information (e.g. a request) (see col 3/lines 3-9), sent email contains information (e.g. status information) (see col 12/lines 24-31). Beilinski discloses that in the illustrated network electronic mail session the designated sending and receiving network controller can be two devices, namely a printer and a computer-to-printer communication, wherein the receiving device can operate independently and simultaneously can support a sending network controller (see col 12/lines 42-50). Therefore, the reference further discloses that a receiving device is configured to send mail messages frames containing status information (e.g. off-line indication) (see col 12/lines 51-62).

6.   Regarding claims 77-100 (Group II) it is further argued (on page 7), that the prior art does not teach limitations of claim 77, specifically, "a monitoring method executed on a business office device".

In response to the above-mentioned argument, it is noted that the preamble is the claim is not a limitation. Specifically, "a monitoring method executed on a business office device" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See In re Hirao, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

7.   Regarding claims 77-100 (Group II) it is further argued (on page 7), that the prior art does not claim 77 limitations as recited, i.e. storing status information of the business office device in one memory within the business office device.

In response to the above-mentioned argument, prior art teaches regarding a network electronic mail session storing in a small buffer all data received or to be send including status information of the business office device to be transmitted as a mail message frame including status information, e.g. off-line status information (see col 12/lines 42-col 13/line 4).

8.   Regarding claims 101-124 (Group III) it is further argued (on page 7) that prior art does not teach claim 101 limitation as recited, specifically, transmitting an email containing status information about business office device, because although the reference discloses email for transfer between computer with data originating at the computer, but not with status information of the business office device.

In response to the above-mentioned argument, it is noted that features upon which applicant relies (i.e., "transmitting an email originated at the business office device and transmitting status information about the business office device") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claim limitation in regard to the computer program product comprising the compute code configured to perform the function of the method, reads, to store information ("status information") of the business office device in a memory.

Prior art teaches a network electronic mail session network mail session refers to communication of sending an mail message to a network node controller from another (col 12/lines 3-13). Mail messages are sent as mail message frames over the network from sending network controller to a receiving network controller. The receiving network node controller communicates to the sending network node controller communicating information, i.e. indicating whenever the receiving network node controller's mailbox becomes full. (col 12/lines 14-31). Further disclosing that in the illustrated network electronic mail session embodiment, two devices can be designated as the receiving network node controller for each sending network node controller. One device is an output device, i.e. printer for a computer-to-printer communication and where the receiving printer operate independently and can simultaneously support a single sending network node controller (col 12/lines 42-50). Each receiving controller (i.e. receiving printer), therefore, is configured to responds to network mail message frames intended for it, and periodically send mail message frames including sending off-line mail message frames when the device is off line; it must maintain a small buffer to receive data frames to send the data to its corresponding object device (col 12/lines 51-62); and wherein each receiving network node controller (printer) also has a small buffer, which holds data sent over the network by the sending network node controller (col 12/lines 63-col 13/line 4). In this

manner, Beilinski teaches storing information ("status information") of the business office device in a memory and transmitting an email containing information ("status information") to a device ("monitoring device").

9. Applicant's arguments have been fully considered but not rendered persuasive.
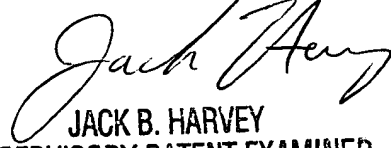
(12) *Conclusion*

The ultimate determination of patentability must be based on consideration of the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The submission of objective evidence of patentability does not mandate a conclusion of patentability in and of itself. In re Chupp, 816 F.2d 643, 2 USPQ2d 1437 (Fed. Cir. 1987). Facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of a prima facie case was reached, not against the conclusion itself. In re Eli Lilly, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990). In other words, each piece of rebuttal evidence should not be evaluated for its ability to knockdown the prima facie case. All of the competent rebuttal evidence taken as a whole should be weighed against the evidence supporting the prima facie case. In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Although the record may establish evidence of secondary considerations which are indicia of nonobviousness, the record may also establish such a strong case of obviousness that the objective evidence of nonobviousness is not sufficient to outweigh the evidence of obviousness. Newell Cos. v. Kenney Mfg. Co., 864 F.2d 757, 769, 9 USPQ2d 1417, 1427 (Fed. Cir. 1988), cert. denied, 493 U.S. 814 (1989); Richardson-Vicks, Inc., v. The Upjohn Co., 122 F.3d 1476, 1484, 44 USPQ2d 1181, 1187 (Fed. Cir. 1997) (showing of unexpected results and commercial success of claimed ibuprofen and psuedoephedrine combination in single tablet form, while supported by substantial evidence, held not to overcome strong prima facie case of obviousness).
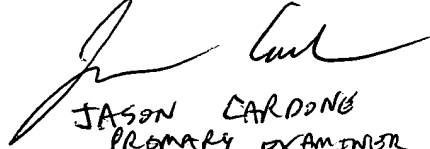
For the reasons above it is believed that the rejection should be maintained.

Respectfully submitted,

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